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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,365	08/07/2000	Bart, Alan Meltzer	16603-714	3951

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EXAMINER

COULTER, KENNETH R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 06/09/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

57

Office Action Summary

Application No.

09/633,365

Applicant(s)

Meltzer et al.

Examiner

Kenneth R. Coulter

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 27, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-69 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 54-56 and 65-67 is/are allowed.
- 6) ☒ Claim(s) 48-53, 57-64, 68, and 69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 16 6) ☐ Other:

Art Unit: 2141

DETAILED ACTION

Response to Amendment

1. The Exhibit filed on 9/27/2002 under 37 CFR 1.131 has been considered but is ineffective to overcome the Baker (U.S. Pat. No. 6,338,067) and Katz (U.S. Pat. No. 6,055,513) references.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Baker and Katz references.

There is no evidence in Exhibit A of machine-readable specifications including at least one of definitions of, and references to definitions of, services offered and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners.

There is no evidence in Exhibit A of data adapted for parsing to identify an input document and one or more transactions which accept said input document.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

Art Unit: 2141

has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 USC 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 USC 122(b). Therefore, this application is examined under 35 USC 102(e) prior to the amendment by the AIPA (pre-AIPA 35 USC 102(e)).

3. Claims 48 - 53, 57 - 64, 68 and 69 are rejected under 35 U.S.C. 102(e) as being disclosed by Baker et al. (U.S. Pat. No. 6,338,067) (Product/Service Hierarchy Database for Market Competition and Investment Analysis).

3.1 Regarding claim 48, Baker discloses a method for establishing transactions among trading partners in a network, comprising:

maintaining a registry of machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners (Abstract; Figs. 1, 2, 6; col. 12, lines 6 - 14); and

Art Unit: 2141

providing, in response to a request, one or more of the machine-readable specifications from said registry is via a communication network to a requesting node (Abstract; Figs. 1, 2, 6; col. 12, lines 6 - 14).

3.2 Per claim 49, Baker teaches that said machine-readable specifications comprises data identifying respective descriptions of sets of storage units and logical structures for the sets of storage units (Abstract; Figs. 5, 6; col. 10, lines 34 - 45).

3.3 Regarding claim 50, Baker discloses that said machine-readable specifications included data adapted for parsing to identify an input document and one or more transactions which accept said input document (col. 12, lines 6 - 14; col. 14, lines 52 - 56).

3.4 Per claim 51, Baker teaches that the definitions of the documents to be exchanged comprise respective descriptions of sets of storage units and logical structures for the sets of storage units (Abstract; Figs. 1, 2, 6; col. 12, lines 6 - 14).

3.5 Regarding claim 52, Baker discloses that the machine-readable specifications include documents compliant with a definition of a predefined document including logical structures for storing an identifier of a particular transaction, and at least one of definitions and references to

Art Unit: 2141

definitions of input and output documents for the particular transaction (Abstract; Figs. 1, 2, 6; col. 12, lines 6 - 14).

3.6 Per claim 53, Baker teaches that the storage units comprise parsed data (col. 12, lines 6 - 14; col. 14, lines 52 - 56).

3.7 Regarding claim 57, Baker discloses that the storage units comprise *unparsed* data (col. 12, lines 6 - 14; col. 14, lines 52 - 56).

3.8 Per claim 58, Baker teaches associating trading partners with said machine readable specifications (Abstract; Figs. 1, 2, 6; col. 12, lines 6 - 14).

3.9 Regarding claims 59 - 64, 68 and 69, the rejection of claims 48 - 53, 57, and 58 (paragraphs 3.1 - 3.8 above) under 35 USC 102(e) applies fully.

4. Claims 48, 49, 51, 52, 58 - 60, 62, 63, and 69 are rejected under 35 U.S.C. 102(e) as being disclosed by Katz et al. (U.S. Pat. No. 6,055,513) (Methods and Apparatus for Intelligent Selection of Goods and Services in Telephonic and Electronic Commerce).

Art Unit: 2141

4.1 Regarding claim 48, Katz discloses a method for establishing transactions among trading partners in a network, comprising:

maintaining a registry of machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners (Abstract; col. 10, lines 34 - 45); and

providing, in response to a request, one or more of the machine-readable specifications from said registry is via a communication network to a requesting node (Abstract; col. 10, lines 34 - 45).

4.2 Per claim 49, Katz teaches that said machine-readable specifications comprises data identifying respective descriptions of sets of storage units and logical structures for the sets of storage units (Abstract; Figs. 5, 6; col. 10, lines 34 - 45).

4.3 Per claim 51, Katz teaches that the definitions of the documents to be exchanged comprise respective descriptions of sets of storage units and logical structures for the sets of storage units (Abstract; Figs. 5, 6; col. 10, lines 34 - 45).

Art Unit: 2141

4.4 Regarding claim 52, Katz discloses that the machine-readable specifications include documents compliant with a definition of a predefined document including logical structures for storing an identifier of a particular transaction, and at least one of definitions and references to definitions of input and output documents for the particular transaction (Abstract; Figs. 5, 6; col. 10, lines 34 - 45).

4.5 Per claim 58, Katz teaches associating trading partners with said machine readable specifications (Abstract; Figs. 5, 6; col. 10, lines 34 - 45).

4.6 Regarding claims 59, 60, 62, 63, and 69, the rejection of claims 48, 49, 51, 52, and 58 (paragraphs 4.1 - 4.5 above) under 35 USC 102(e) applies fully.

5. Claims 48 - 53, 57 - 64, 68 and 69 are rejected under 35 U.S.C. 102(e) as being disclosed by Mehr et al. (U.S. Pat. No. 6,141,658) (Computer System and Method for Managing Sales Information).

5.1 Regarding claim 48, Mehr discloses a method for establishing transactions among trading partners in a network, comprising:

maintaining a registry of machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of

Art Unit: 2141

definitions of, and references to definitions of, services offered and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners (Abstract; Fig. 18; col. 2, lines 1 - 10; col. 4, lines 49 - 63); and

providing, in response to a request, one or more of the machine-readable specifications from said registry is via a communication network to a requesting node (Fig. 9; col. 8, lines 50 - 62; col. 4, lines 49 - 63).

5.2 Per claim 49, Mehr teaches that said machine-readable specifications comprises data identifying respective descriptions of sets of storage units and logical structures for the sets of storage units (Abstract; Figs. 7, 12, 13).

5.3 Regarding claim 50, Mehr discloses that said machine-readable specifications included data adapted for parsing to identify an input document and one or more transactions which accept said input document (Figs. 12, 13; col. 8, lines 15 - 23).

5.4 Per claim 51, Mehr teaches that the definitions of the documents to be exchanged comprise respective descriptions of sets of storage units and logical structures for the sets of storage units (Abstract; Figs. 7, 12, 13).

Art Unit: 2141

5.5 Regarding claim 52, Mehr discloses that the machine-readable specifications include documents compliant with a definition of a predefined document including logical structures for storing an identifier of a particular transaction, and at least one of definitions and references to definitions of input and output documents for the particular transaction (Abstract; Figs. 7, 12, 13).

5.6 Per claim 53, Mehr teaches that the storage units comprise parsed data (Figs. 12, 13; col. 8, lines 15 - 23).

5.7 Regarding claim 57, Mehr discloses that the storage units comprise *unparsed* data (Figs. 12, 13; col. 8, lines 15 - 23).

5.8 Per claim 58, Mehr teaches associating trading partners with said machine readable specifications (Abstract; Fig. 18).

5.9 Regarding claims 59 - 64, 68 and 69, the rejection of claims 48 - 53, 57, and 58 (paragraphs 5.1 - 5.8 above) under 35 USC 102(e) applies fully.

Art Unit: 2141

Allowable Subject Matter

6. Claims 54 - 56 and 65 - 67 are allowed.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Coulter whose telephone number is (703) 305-8447.

KENNETH R. COULTER
PRIMARY EXAMINER



krc

June 3, 2003